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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/538,750	03/30/2000	Jay S. Walker	00-017	8975
22927	7590	10/19/2004	EXAMINER	
WALKER DIGITAL FIVE HIGH RIDGE PARK STAMFORD, CT 06905			HAQ, NAEEM U	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/538,750

Applicant(s)

WALKER ET AL. 

Examiner

Naeem Haq

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) 1-61 and 65-70 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 62-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This action is in response to Applicants' amendment filed on July 19, 2004.

Claims 1-70 are pending and will be consider for examination.

Election/Restrictions

Newly amended claims 1-61 and 65-70 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 1-61 and 65-70 have been amended to recite the limitation that the second consumer is entitled to the transferable item price irrespective of whether second consumer would otherwise be entitled to purchase the item for the payment of the amount.

Since applicant has received an action on the merits for the originally presented invention (claims 62-64), this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1-61 and 65-70 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 101

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 62-64 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

These claims make only nominal use of technology and are therefore not within the technological arts. *Ex parte Bowman* requires non-trivial recitation of technology in the body of the claim language. In the present case, claims 62-64 recite a nonnominal use of technology (i.e. memory of a computing device). The step of determining does not require technology and can be performed by hand. *The claimed invention must utilize technology in a non-trivial manner (Ex parte Bowman, 61 USPQ2d, 1665,1671 (Bd. Pat. App. & Inter. 2001))*. Although Bowman is not precedential, it has been cited for its analysis. For this reason, claims 62-64 are deemed to be non-statutory subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 63 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This claim recites two steps (i.e. associating and determining) that are unrelated to each other. The first consumer and first merchant in the associating step and the second consumer and second merchant in the determining

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step have no logical connection to each other. It is unclear to the Examiner how these to steps related.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 62 is rejected under 35 U.S.C. 102(b) as being anticipated by Walker Asset Management Limited Partnership (WO 99/03056) hereinafter referred to as Walker.

Referring to claim 62, Walker teaches a method of facilitating a transaction, comprising: associating, in memory of a computing device, a transferable item price established between a consumer and a first merchant (page 7, lines 1-3, lines 22 – page 8, lines 16); determining that the consumer is entitled to purchase an item from a second merchant in exchange for payment of an amount based on the transferable item price (page 16, lines 17-26).

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 64 is rejected under 35 U.S.C. 102(e) as being anticipated by Ikeda et al. (US 5,937,391).

Referring to claim 64, Ikeda teaches a method of facilitating a transaction, comprising: associating, in a memory of a computing device, a transferable item price with a first consumer (column 2, lines 29-38; column 3, lines 52-58; column 4, lines 27-35). The Applicants' specification teaches that a transferable item price "...may represent, for example, a price at which a merchant is willing to sell an 'item' to the first consumer..." (page 5, lines 16 and 17). Ikeda teaches that a merchant issues points based on a purchase amount (i.e. transferable item price). Ikeda also teaches determining that the first consumer is entitled to transfer a benefit to a second consumer specified by the first consumer, wherein the benefit is based on the transferable item price (column 9, line 55 -- column 10, line 2). The Applicants' specification teaches that a consumer "...may be any party (e.g., an individual, a group of individuals, or business) that purchases an item, indicates an interest in purchasing an item, or otherwise arranges to be associated with a transferable item price" (page 5, lines 12-15). Ikeda teaches that an individual donates (i.e., transfers) points (i.e., a benefit) to a second individual or organization by specifying the ID of the receiver, wherein the benefit is based on the purchase amount (i.e. transferable item price).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 63 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker Asset Management Limited Partnership (WO 99/03056) hereinafter referred to as Walker.

Referring to claim 63, Walker teaches a method of facilitating a transaction, comprising: associating, in memory of a computing device, a transferable item price established between a consumer and a first merchant (page 7, lines 1-3, lines 22 – page 8, lines 16); determining that the consumer is entitled to purchase an item from a plurality of merchants in exchange for payment of an amount based on the transferable item price (page 16, lines 17-26). Walker does not teach a first and second consumer. However, Walker's method is available to a plurality of consumers who may interact with a plurality of merchants. Furthermore, Walker does not restrict his invention to only one consumer. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have a second consumer in the invention of Walker. One of ordinary skill in the art would have been motivated to do so in order to facilitate transactions among a plurality of consumers and a plurality of merchants.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (703)-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naeem Haq, Patent Examiner
Art Unit 3625



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October 11, 2004